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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,358

01/16/2004

Donna A. Piacenza

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MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

EXAMINER

AKRAM, IMRAN

ART UNIT

PAPER NUMBER

1709

MAIL DATE

DELIVERY MODE

05/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/759,358

Applicant(s)

PIACENZA ET AL.

Examiner

Imran Akram

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/04/05, 4/17/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Specification

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 8, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Scordato (US 2002/0012613).

Regarding claim 1, Scordato discloses a pivotable nozzle assembly for attaching a pipette tip to a pipette device with a pipette coupling (paragraph 3) and a nozzle pivot mechanism with a portion for engaging the pipette coupling and a portion for pivoting the nozzle assembly (paragraph 36). It is well known in the pipette art that pipette tips are nothing more than small pipettes themselves.

Regarding claim 7, Scordato discloses a pipette device comprising a housing (paragraph 9), a nozzle for accepting a pipette tip (paragraph 3), and a pivot selector on the housing to adjust the pivot angle of the nozzle (paragraph 9).

Regarding claim 8, Scordato discloses the features of claim 7 and an ergonomic hand grip (paragraph 13).

Regarding claim 15, Scordato discloses a pipette device comprising a housing (paragraph 9), a coupling for removably engaging a pipette tip (paragraph 3), and a

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pivot selector on the housing to adjust the pivot with respect to the housing (paragraph 9).

Regarding claim 16, Scordato discloses the features of claim 15 and indexing means to discretely adjust the pipette pivot angle (paragraph 36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato (US 2002/0012613) as applied to claim 1, and further in view of Steele (US 6,253,628 B1).

Regarding claim 2, Scordato discloses a nozzle housing releasably engaged with the pivot mechanism (see paragraph 36). Scordato does not, however, disclose the specifics of the pipette coupling being contained within the nozzle housing. Steele discloses a nozzle housing enclosing a pipette coupling (column 4, lines 31-40). It would be obvious to one skilled in the art at the time the invention was made to enclose the pipette coupling within the nozzle because it is commonly known in the art for a pipette coupling to be contained within a nozzle housing (see US 4,527,437 and US 3,963,061).

Regarding claim 3, Scordato discloses a nozzle housing and pivot mechanism engaged with one another (see paragraph 36). Scordato does not, however, disclose the specifics of the nozzle housing being threadably engaged with the pivot mechanism. Steele discloses a housing threadably engaged with the complementary portion of the pipette body (see column 4, lines 26-29). It would be obvious to one skilled in the art at the time the invention was made to threadably engage the nozzle housing with the pivot mechanism because it is commonly known in the art to threadably engage a nozzle housing with its complementary body portion.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato (US 2002/0012613) as applied to claim 1, and further in view of Raczak (US 3,656,351).

Regarding claim 4, Scordato discloses a plurality of indexing holes for pivotably orienting the nozzle assembly at a plurality of discrete angles (see paragraph 36). The screws of paragraph 36 are read have complementary holes as this is commonly known about the function of screws. Scordato does not, however, disclose pivot bosses defining a pivot axis. Raczak discloses a pivot boss about which a nozzle assembly pivots (see column 1, line 66). It would be obvious to one skilled in the art at the time the invention was made to use bosses to pivot the nozzle assembly because it is commonly known in the art to do so. The number of pivot bosses defines only the preferred movement and it would have been obvious to include two in Scordato because of the type of movement claimed.

Regarding claim 5, Claim 5 is read to include at least four indexing holes. Scordato discloses at least thirty-six (paragraph 36) indexing holes since the pivot angles are 10 degrees.

Regarding claim 6, Raczak discloses a pivot boss that is generally frustoconical (see 22, Figure 2). Again, the number of pivot bosses defines only the preferred movement and it would have been obvious to include two in Scordato because of the type of movement claimed.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato (US 2002/0012613) as applied to claim 7, and further in view of Raczak (US 3,656,351).

Regarding claim 9, Scordato does not disclose pivot sleeves. Raczak, however, discloses a pivot recess for engaging a pivot boss (see **51**, Figure 2). It would be obvious to one skilled in the art at the time the invention was made to include pivot sleeves with pivot bosses because the two by function cannot work without one another. The number of pivot bosses defines only the preferred movement and it would have been obvious to include two sleeves in Scordato because of the type of axial movement claimed.

Regarding claim 10, Scordato discloses a plurality of indexing holes for pivotably orienting the nozzle assembly at a plurality of discrete angles (see paragraph 36). The screws of paragraph 36 are read have complementary holes as this is commonly known about the function of screws. Scordato does not, however, disclose pivot bosses rotatably retained in pivot sleeves. Raczak discloses a pivot sleeve for engaging a pivot boss (see **51**, Figure 2). The number of pivot bosses defines only the preferred movement and it would have been obvious to include two sleeves in Scordato because of the type of movement claimed.

Regarding claim 11, Raczak discloses a pivot boss (see **22**, Figure 2) and a pivot sleeve for engaging a pivot boss (see **51**, Figure 2) that are generally frustoconical (column 1, line 66). The number of pivot bosses and complementary pivot sleeves

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define only the preferred movement and it would have been obvious to include two bosses and sleeves in Scordato because of the type of movement claimed.

Regarding claim 12, Claim 12 is read to include at least four indexing holes. Scordato discloses at least thirty-six (paragraph 36) indexing holes since the pivot angles are 10 degrees.

Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato (US 2002/0012613) and Raczak (US 3,656,351) as applied to claim 12, and further in view of Sturm (US 4,099,548).

Regarding claim 14, neither Scordato nor Racak disclose a slideable release having a pair of projections for engaging a pair of holes and a spring for biasing said slideable release to an engaged position with the indexing surface. Sturm, however, discloses a slideable release **19** having a projection **49** for engaging at least two holes in rack **43** and a spring **63** for biasing the slideable release **19** to an engaged position with the indexing surface (column 4, lines 1-3).). It would be obvious to one skilled in the art at the time the invention was made to use a spring and slideable release as their purpose is to return the pipette to its rest position and this is a known means to do so.

Regarding claim 17, Scordato discloses gripping means for reducing hand fatigue (paragraph 38).

Allowable Subject Matter

Claims 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Imran Akram whose telephone number is 571-270-3241. The examiner can normally be reached on 8-6 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IA

Mehna Mayes
Primary Examiner
AU 1734